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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/807,846	03/24/2004	David A. Bulpett	B03-31	5470

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EXAMINER

BUTTNER, DAVID J

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 08/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/807,846	Applicant(s) BULPETT ET AL.	
	Examiner David Buttner	Art Unit 1712	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-55 is/are pending in the application.
 4a) Of the above claim(s) 14-24 and 39-55 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13 and 25-38 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

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The lined out references on the 1449 form were not provided.

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-13 and 25-38, drawn to radiation treating and isomerizing polybutadiene, classified in class 522, subclass 55.
- II. Claims 14-24 and 39-50, drawn to heat treating and isomerizing polybutadiene, classified in class 525, subclass 333.2.
- III. Claims 51-55, drawn to a golf ball having a certain cure gradient and certain trans gradient, classified in class 473, subclass 371.

The inventions are distinct, each from the other because:

The methods of I and II require distinct steps, I requiring irradiation and II requiring thermolysis. III does not require any isomerization.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

During a telephone conversation with Bill Lacy on 8/17/05 a provisional election was made with traverse to prosecute the invention of I, claims 1-13 and 25-38.

Affirmation of this election must be made by applicant in replying to this Office action.

Claims 14-24 and 39-55 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 5 and 6 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is not clear what these percentages refer to. Is the amount of trans structure in the trans polybutadiene being limited? Is the amount of trans polybutadiene in the entire composition being limited (ie requiring other blending partners to be present)?

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1,3-7 and 10-13 rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Yokota '295.

Yokota exemplifies (table 2) golf ball covers of trans polybutadiene. Yokota does not show how this trans polybutadiene was prepared, but there is no reason to believe the Yokota's rubber is any different from the material resulting from applicant's product by process limitation. The burden to show otherwise is shifted to applicant (MPEP 2113).

Claims 1-7 and 10-13 rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bissonnette 2002/0119837.

Bissonnette claims (#25) golf balls of a blend of trans polybutadiene with cis polybutadiene. The trans polybutadiene can be FUREN 88 (paragraph 65). Bissonnette does not explain how this trans polybutadiene was prepared, but there is no reason to believe this rubber is any different from the material resulting from applicant's product by process limitation. The burden to show otherwise is shifted to applicant (MPEP 2113).

Claims 1-7 and 10-13 rejected under 35 U.S.C. 102(e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Bissonnette 2002/0119834.

Bissonnette exemplifies golf balls of trans polybutadiene. Bissonnette does not explain how these trans polybutadienes were prepared, but there is no reason to believe these rubbers are any different from the material resulting from applicant's product by process limitation. The burden to show otherwise is shifted to applicant (MPEP 2113).

Claims 1-13 and 25-38 rejected under 35 U.S.C. 103(a) as being unpatentable over Yokota '295 or Bissonnette 2002/0119837 or Bissonnette 2002/0119834 in view of Golub '175.

Each of the primary references call for trans polybutadiene for use in golf balls, but do not suggest obtaining the trans polybutadiene by irradiating a cis polybutadiene.

Such a technique for making trans polybutadiene is known. Golub exemplifies such methods. Golub (col 6 line 34) suggests his converted polybutadienes are suitable

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for any use. It would have been obvious to utilize Golub's conversion technique to obtain trans polybutadiene for use in any of the primary reference's golf balls.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Buttner whose telephone number is 571-272-1084. The examiner can normally be reached on weekdays from 10 to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy Gulakowski, can be reached on 571-272-1302. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David Buttner

8/17/05

DAVID J. BUTTNER
PRIMARY EXAMINER

